

REMARKS

I. Introduction

Claims 1-15 are pending in the above application.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a).

Claims 10-15 are newly added.

Claims 1 and 10 are independent claims.

II. Amendments

Claim 1 has been amended to more concisely claim that which applicant regards as the invention therein. Claims 10-15 are newly added.

Support for the amendments to claim 1 and the limitations of claims 10-15 may be found at least in Figures 2 and 4 and on page 6, line 22 through page 7 line 24 and page 10, line 25 through page 11, line 24 of the specification.

No new matter has been added.

III. Prior Art Rejections

A. Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Okawa et al. (JP Pub. 61-294961) (hereafter "Okawa") in view of Kotsuki et al. (U.S. Pat. 6,020,974) (hereafter "Kotsuki").

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the *claimed invention* where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolchem Inc. v. Southern*

California Edison Co., 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). See also MPEP 2143.01.

Neither Okawa nor Kotsuki, taken alone or in combination, disclose or suggest the combination of elements of amended claim 1 as a whole, including using audio information, including a response message individually prerecorded for each of a plurality of predetermined, each of the callers being identified by caller information thereof, wherein, a central controller reproduces the response message for a call which the caller information detector detects to be from at least one of the predetermined callers. Okawa merely discloses a conventional voice storage system without a caller information detector. Kotsuki discloses a caller ID detector for detecting caller information from an input signal incoming from the network. Neither Okawa nor Kotsuki, taken alone or in combination, disclose or suggest at least the above features of amended claim 1. Accordingly, as neither Okawa nor Kotsuki, taken alone or in combination produce the claimed invention of amended claim 1, neither Okawa nor Kotsuki, taken alone or in combination, render amended claim 1 as obvious.

B. Claim 2 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Okawa in view of Kotsuki and further in view of Hidetoshi (JP Pub. 63-261,948) (hereafter "Hidetoshi").

Claim 2 is dependent on independent claim 1 and hence, incorporates all of the limitations thereof. See, 35 U.S.C. § 112 para. 4. The addition of Hidetoshi to the

combination of Okawa and Kotsuki does not cure the deficiencies of the combination, *i.e.* the spurious combination of these three references, even if considered proper, *arguendo*, does not produce the claimed invention recited in amended claim 1 and dependent claim 2. Accordingly, the combination of Okawa, Kotsuki and Hidetoshi, does not render claim 2, which incorporates the limitations of amended claim 1, unpatentable as being obvious.

C. Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Okawa in view of Kotsuki and further in view of Hirose et al. (U.S. Pat. 5,347,646) (hereafter “Hirose”) in view of Yoshiaki et al (JP Pub. 5-176060) (hereafter “Yoshiaki”) and in view of Hidetoshi.

Claim 3 is dependent on independent claim 1 and hence, incorporates all of the limitations thereof. See, 35 U.S.C. § 112 para. 4. The addition of Hirose, Yoshiaki, and Hidetoshi to the combination of Okawa and Kotsuki does not cure the deficiencies of the combination of Okawa and Kotsuki, *i.e.* the spurious combination of these *five* references, even if considered proper, *arguendo*, does not produce the claimed invention recited in amended claim 1 and dependent claim 3. Accordingly, the combination of Okawa, Kotsuki, Hirose, Yoshiaki and Hidetoshi, does not render claim 3, which incorporates the limitations of amended claim 1, unpatentable as being obvious.

D. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Okawa in view of Kotsuki and further in view of Morganstein et al. (U.S. Pat.

5,249,219) (hereafter "Morganstein") in view of Hirosawa in view of Yoshiaki and in view of Hidetoshi.

Claim 4 is dependent on independent claim 1 and hence, incorporates all of the limitations thereof. See, 35 U.S.C. § 112 para. 4. The addition of Morganstein, Hirosawa, Yoshiaki and Hidetoshi to the combination of Okawa and Kotsuki does not cure the deficiencies of the combination of Okawa and Kotsuki, *i.e.* the spurious combination of these *six* references, even if considered proper, *arguendo*, does not produce the claimed invention recited in amended claim 1 and dependent claim 4. Accordingly, the combination of Okawa, Kotsuki, Morganstein, Hirosawa, Yoshiaki and Hidetoshi, does not render claim 4, which incorporates the limitations of amended claim 1, unpatentable as being obvious.

E. Claims 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okawa in view of Kotsuki and further in view of Morganstein in view of Yoshiaki and in view of Hidetoshi.

Each of claims 5-9 are dependent on independent claim 1 directly or indirectly, and hence, each of claims 5-9 incorporate all of the limitations of amended claim 1. See, 35 U.S.C. § 112 para. 4. The addition of Morganstein, Yoshiaki and Hidetoshi to the combination of Okawa and Kotsuki does not cure the deficiencies of the combination of Okawa and Kotsuki, *i.e.* the spurious combination of these *five* references, even if considered proper, *arguendo*, does not produce the claimed invention recited in amended claim 1 and any of dependent claims 5-9. Accordingly, the combination of Okawa,

Kotsuki, Morganstein, Yoshiaki and Hidetoshi, does not render any of claims 5-9, each of which incorporates the limitations of amended claim 1, unpatentable as being obvious.

IV. New Claims 10-15

Claims 10-15 are believed to be patentable because they are believed to recite combinations which are not disclosed or suggested by the prior art.

V. Conclusion

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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